

REMARKS

Claims 1-15 were pending in the present application. Claims 2, 4, 6, 8, 10, and 12-15 have been amended. Claims 1, 3, 5, 7, 9, and 11 have been cancelled without prejudice or disclaimer. Support for the claim amendments can be found at least in the original claims and Figs. 1-4. Accordingly, applicant respectfully submits that no new matter has been added.

It is respectfully requested that this Amendment and Reply be considered and entered after final because (1) it is believed to place the application in condition for allowance, and (2) it should not require any further searching by the Examiner.

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons which follow.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier.

Information Disclosure Statement

Applicant has not received an initialed PTO SB/08 form for the IDS filed on March 27, 2002. The Examiner is requested to provide the initialed PTO form in accordance with MPEP § 609.

Claim Rejections Under 35 U.S.C. § 103(a)

In the Office Action, claims 1-15 were rejected under 35 U.S.C. § 103 as being unpatentable over Strobel et al. (USP 5,204,820) in view of Bertling et al. (USP 5,440,456). Applicant respectfully traverses these rejections for at least the following reasons.

The rejections regarding claims 1, 3, 5, 7, 9, and 11 are now moot as those claims have been cancelled without prejudice.

Regarding the rejection of claim 2, now amended to be placed in independent form, applicant respectfully submits that the cited art fails to teach or suggest: "wherein the reflection surface of said reflector is structured such that a vertical cross section of the reflection surface and a horizontal cross section of the reflection surface each substantially have a shape that is part of an oval larger than a front surface and a back surface of said lens."

Applicant respectfully disagrees with the relevance of the PTO's position (as stated on page 5 of the office action) that "it is clearly visible of Fig. 1 of Bertling that the reflector [10] has reflecting surface which is larger than the recessed surface [28] of the lens [24]" because previously pending claim 2 recited "a shape that is part of an oval larger than said lens." The lenses 24, 124, and 224 of Bertling, as shown in Figs. 1, 2, and 3, have the same diameter as the diameter of the front edge 22 of the reflector. While the curved portion of Bertling's lens 24 may have a smaller size than the reflector surface, the entire lens 24, including front surface 26 and back surface 28, is not smaller than the reflector shape. In order to clarify this difference even further, applicant has amended claim 2 to recite "a shape that is part of an oval larger than a front surface and a back surface of said lens." The combination of Bertling/Strobel does not teach or suggest this feature.

In addition, applicant respectfully traverses the rejections of claims 6, 8, 10, and 12 because the Examiner has not met his burden in establishing a *prima facie* case of obviousness. On page 4 of the office action, the Examiner states that "It is understood that the free curved surface may be provided on any surface of the lens (front, back, or both) depending on necessity." This explanation fails to provide the necessary evidence to establish that one of ordinary skill in the art would have been motivated to combine the references to produce applicant's claimed invention. It is unstated what "necessity" would have motivated a person of ordinary skill in the art to modify Strobel/Bertling in the manner alleged.

In levying an obviousness rejection under 35 U.S.C. 103, the Examiner has the burden of establishing (1) some suggestion or motivation to modify the reference or to combine reference teachings, (2) a reasonable expectation of success, and (3) that the prior art references, when combined, teach or suggest all the claim limitations. See

MPEP §2143 (Aug. 2001). "Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438 (Fed. Cir. 1991). In addition, *In Re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999) states "Our case law makes clear that the best defense against a subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for the showing of the teaching or motivation to combine prior art references." Further, the Court states "Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." The Court also states "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'."

In the present case, the Office Action provides no evidence of any motivation from the prior art itself to have a structure that includes "a torus curved surface or a free curved surface" formed on one or both of the front surface and the back surface of the lens, as is recited in one or more of claims 6, 8, 10, and 12. In relying on the "necessity" that a particular structure might be used to provide, the office action is silent as to what particular "necessity" is provided in the cited art. Instead, the only reason to have applicant's claimed structure is provided in the application itself, which is not available as prior art in making an obviousness rejection. Further, there is no evidence provided that there would be any reasonable expectation of success.

In addition, with respect to the rejections of claims 13-15, again, there is no evidence as to why one of ordinary skill in the art would have been motivated to utilize a bi-concave or concave-convex shape just because such structures are known. These structures are clearly not taught in the cited art and the cited art does not provide any necessity for using such lens structures.

Moreover, the Office Action dated April 30, 2003 does not address applicant's previous argument that the specification (at page 20, line 11 – page 23, line 23) provides evidence of the unexpected and improved results over the prior art. This secondary consideration must be taken into account when rendering an obviousness rejection.

Thus, for at least the reasons stated above, applicant respectfully submits that the pending claims are allowable over the cited art.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

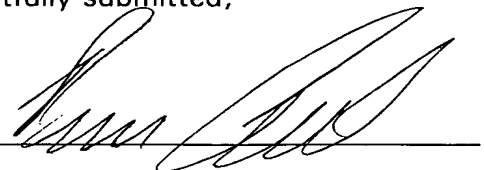
Conclusion

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date July 9, 2003

By 

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